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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/861,231	05/21/97	ILVESPA A	H 1781-73

QM02/0906
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NEW YORK NY 10176

EXAMINER

WILSON, P

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 09/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Applicati n N .

08/861,231

Applicant(s)

ILVESPAA, HEIKKI

Examiner

Pamela A Wilson

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-- Th MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26,28-34 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-25 is/are allowed.
- 6) ☒ Claim(s) 26,28-34 and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 May 1997 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Detailed Action

In view of the REMAND TO THE EXAMINER filed on July 16, 2001, PROSECUTION IS HEREBY REOPENED. A new ground of rejection (as presented in the Remand to the Examiner as Issue 2) is set forth below. The additional concerns presented in the Remand to the Examiner, and presented as Issues 1 and 3, will also be addressed.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of normal dryer groups including the arrangement of the device for applying heat and moisture to the web with the device oriented as it exits the plurality of normal dryer groups or

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immediately downstream of the plurality of normal dryer groups must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Specification

a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it fails to provide a sufficient and proper disclosure for the claim language of (1) a plurality of top-felted single-tier normal dryer groups, and (2) the location of the device for applying heat and moisture to the paper web as the web exits from the plurality of normal dryer groups or immediately downstream of the plurality of normal dryer groups.

Claim Rejections - 35 USC § 112

This rejection is presented in response to Issue 2 as presented in the
Remand to the Examiner.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26, 28-34 and 36-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the original patent specification, SN 07/808,161, upon which the present reissue is based, in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *Gentry Gallery, Inc. v. Berkline Corp.* (Fed. Cir January 1988), and *Tronzo v. Biomet, Inc.*, USPQ2d 1829 (Fed. Cir August 28, 1998).

In the reissue application, method claim 26 and apparatus claim 34 present a plurality of top-felted single tier normal dryer groups. Although, the Applicant's original disclosure presents single-tier normal dryer groups, it does not provide proper and sufficient support for a plurality of single-tier normal dryer groups; nor does it provide proper and sufficient support for the claimed location of the device for applying heat and moisture to the paper web as the web exits from the plurality of normal dryer groups or immediately downstream of the plurality of normal dryer groups.

Recapture Rejection - 35 USC § 251

This rejection is presented in response to Issue 1 as presented in the Remand to the Examiner.

Claims 26, 28-34 and 36-41 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the parent application of SN 07/808,161. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The principles of the recapture rule, as applied in *Hester Industries, Inc. V. Stein Inc.*, 46 USPQ 2d 1641 (Fed. Court 1998) are considered to be applicable to the facts of the present application in that the reissue claims presented by the Applicant contain limitations which are not considered to be materially narrower than those of the actual

surrendered subject matter as presented in the parent application of SN 07/808,161; and thus, the Recapture rule cannot be avoided.

In the reissue application of SN 08/861,231 the claims 26, 28-34 and 36-41 when compared with the actual surrendered subject matter of claims 1, 18 and 22, as presented in Paper #8 of Application No. 07/808,161, and claim 8, as presented in Paper #11, therein, are considered to contain broadened claim language.

The limitation of the application of steam in a steam treatment, which was presented in parent Application No. 07/808,161 is not found in the reissue claims of 26, 28-34 and 36-41. In lieu of the limitation regarding the application of "steam", as presented in the parent application, the aforementioned reissue claims recite the limitation of applying "heat and moisture" to the dried paper web. The limitation of applying "heat and moisture" is considered to be broader in scope than the limitation of applying "steam" because the application of "heat and moisture" encompasses a range of physical states of matter whereas the limitation of "steam" is considered to simply encompass the vapor phase of water, as defined by Webster's II: New Riverside University Dictionary © 1994.

Furthermore, in the reissue application, apparatus claim 28, which depends from independent claim 26, recites that the "guide rolls are suction cylinders." This claim limitation was amended into the claim language of the patent claims of SN 07/808,161 in response to art rejections presented by the examiner (see amendment A, paper #5). Therefore, omitting this aforementioned limitation from the reissue claim language of claim 26 does not afford the Applicant of avoiding the effect of the Recapture rule.

The following is in response to Issue 3 as presented in the Remand to the Examiner.

The examiner was asked to consider whether a prior art rejection of the reissue claims 26, 28-34 and 36-41 would be appropriate; and the examiner was further asked to consider the appellants' disclosure in the "Background" section of the application which discloses that paper making machines that have single-wire draws in a drying section, however, these single-wire drying groups have been interpreted as normal drying groups. This forementioned disclosure relates to inverted drying groups which consist of every other dryer group, in a plurality of dryer groupings, to be oriented in an inverted position. Whereas, a plurality of normal dryer groups is comprised of a series of dryer groups arranged in the same orientation as all of the dryer groups combined to form the plurality of dryer groups.

Additionally, the examiner was asked to consider whether a prior art rejection of the reissue claims 26, 28-34 and 36-41 would be appropriate; and the examiner was asked to further consider the appellants' disclosure in the "Background" section of the application which discloses that steam spraying of a paper web during the step known as calendaring was implemented to relax stresses in the fibers of the paper web by the effect of heat and moisture. However, the term "calendaring" refers to a step which allows a web to run through a series of cylinders or rollers which are oriented in a vertically stacked formation which provides a compression or nip pressure mechanism

during the processing of the web. This calendaring process is not considered to be analogous to the process performed by a normal dryer group.

Finally, the examiner was asked to evaluate any other relevant prior art that she is aware of in determining if the claims on appeal are patentable or not. The examiner has thoroughly reviewed and evaluated all relevant prior art regarding the applicability of the reissue claims on appeal and has found no prior art to be of any pertinent nature.

Allowable Subject Matter

Claims 1-25 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela A Wilson whose telephone number is 703/308-2620. The examiner can normally be reached on Mon - Fri, 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise L Esquivel can be reached on 703/308-2597. The fax phone numbers for the organization where this application or proceeding is assigned are 703/305-3463 for regular communications and 703/305-3463 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0861.

A handwritten signature in cursive script that reads "Pamela A. Wilson".

Pamela A Wilson

Primary Examiner

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paw

September 4, 2001